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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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David Hall

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07/14/2006

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EXAMINER

ABEDIN, SHANTO

ART UNIT

PAPER NUMBER

2136

DATE MAILED: 07/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	10/052,332		HALL, DAVID	
	<b>Examiner</b>		<b>Art Unit</b>	
	Shanto M Z Abedin		2136	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE \_\_\_\_\_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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**DETAILED ACTION**

1. This is in response to the amendment filed on 21 April 2006.
2. The examiner would like to point out that this action is made **FINAL** (MPEP 706.07a).
3. Claim 1-16 were currently presented for the examination.
4. Claim 1-16 have been rejected.

***Response to Arguments***

5. Applicant's arguments with respect to claims 1-16 have been considered but are moot in view of the new ground(s) of rejection.

Regarding claim 1-16, the applicant primarily argues:

(i) the references Schlauch, DiCesare, or Soules does not individually or in combination teaches: (a) the memorabilia article and the identification tag are encapsulated in the transparent housing at an encapsulation facility under the supervision of an authentication service; and (b) a biological marker disposed within the marker area, the biological marker invisible to the naked eye and visible under light in specific wavelengths.

(ii)(a) combination of the reference Schlauch and Soules is improper because of hindsight reasoning, and (b) either of Schlauch or Soules teaches tamper evident transparent thermoplastic housing.

In response to the applicant's above arguments (i)(a), (i)(b) and (ii)(b) regarding claims 1-16, they have been fully considered, but they are moot in the view of new ground of rejections (see below).

In response to the applicant's above arguments (ii) (a) regarding claims 1-16, the examiner respectfully disagrees with the applicant.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In particular, the reference Soules et al teaches a coded identification card, and other standardized documents. Soules' coding is a photograph...or fingerprint (Soules, abstract); Soules' standardized document is a label which identifies an article of arbitrary size (Col 2, lines 52-58) or other document unrelated to any card game (Soules, col 1, lines 11-15), or a plastic card (Soules, lines, 19-23), or a warranty deeds (Soules, Col 3, lines 5-10); Soules' document/ card is a multilayered card (Soules, col 5, lines 28-35); and Soules invention is related to designing a tamper proof card (Soules, Col 11, lines 5-11). Similarly, Schlauch teaches collector/ non-collector document/ article (Col 1, lines 45-67), comprising base and integral attribute/ indicia portions (Col 9, lines 5-11; Col 10, lines 16-27), and related to anti-counterfeiting features (Schlauch ; Col 6, lines 40-46). Therefore, it would be obvious to a person of ordinary skill of art to combine the teachings of Soules et al with teachings of Schlauch to design a method of producing a memorabilia article further comprising a attribute/ indicia which is not visible under naked eyes in order to provide a stronger anti-counterfeiting features in a tamper proof card (Soules, Col 11, lines 5-11; Schlauch ; Col 6, lines 40-46).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 1-5 are rejected under 35 USC 103 (a) as being unpatentable over Carse (Pat. No. US 6102207) in view of DiCesare et al (Pat. No: US 5971435).

***Regarding claim 1,*** Carse discloses an authenticated memorabilia system, the system comprising:

a housing, the housing having front and rear portions (Fig 4A, 4B; Col 1, lines 52-65; Col 4, lines 20-35; top and bottom level; case),

the front and rear portions including mirror-image indentations, the indentations defining receptacles when the housing portions are mated together (Col 1, lines 52-65; Col 4, lines 5-56; top and bottom level; inner and outer surface; case) ;

a memorabilia article disposed in first one of the receptacles (Col 1, lines 15-25; Col 4, lines 5-20, 36-44; collectable article; inner surface; first tray member);

an identification tag disposed in a second one of the receptacles, the identification tag (Col 3, lines 55-67; Claim 10; certification indicia; certificate; Carse implies, or at least teaches enablement of identification tag as a part of the certificate);

the front and rear housing portions are constructed of a substantially transparent material such that a front and rear surface of the memorabilia article and a front and rear surface of the identification

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tag are visible through the front and rear housing portions (Col 4, lines 43-55; Claim 17,25; visible; transparent material; viewing section);

the memorabilia article and the identification tag are encapsulated in the transparent housing at an encapsulation facility (Col 4, lines 5-20, 36-44; collectable article; case; inner surface; first tray member; Col 3, lines 55-67; Claim 10; certification indicia) under the supervision of an authentication service and the housing permanently sealed along a periphery such that neither the memorabilia article nor the identification tag may be removed therefrom without providing visual indication of tampering on the housing (Col 1, lines 35-40, 53-65; Claim 6; tamperproof sealing).

Carse does not disclose expressly the identification tag including an authenticated autograph of a unique individual associated with the memorabilia article; and encapsulation facility under the supervision of an authentication service.

However, DiCesare et al discloses the identification tag including an authenticated autograph of a unique individual associated with the memorabilia article ( Claim 1,6,9; autographed article); and encapsulation facility under the supervision of an authentication service (Col 3, lines 46-49; Col 5, Claim 1,19, authenticating company; representative of authentication service, witnessing autographing; witnesses; DiCesare et al implies, or at least teaches enablement of encapsulation facility under the supervision of an authentication service).

DiCesare et al and Carse are analogous art because they are from the same field of endeavor of authenticating an autographed item/ card. At the time of invention, it will be obvious to a person with ordinary skill of art to combine the teachings of DiCesare et al with Carse to design a memorabilia system further comprising the steps of identification tag including an authenticated autograph of a unique individual associated with the memorabilia article, and encapsulation facility

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under the supervision of an authentication service in order to add further security to the authentication system (DiCesare et al, Col 2, lines 36-47).

***Regarding claim 2***, it is rejected applying as above rejecting claim 1, furthermore, Carse discloses the memorabilia system, wherein the housing portions are constructed of a clear thermoplastic material which does not offer any impairment to visualization of either the memorabilia article or the identification tag (Col 3, lines 25-35; Claim 2-3, 10, 19,26; certification indicia; viewing section).

***Regarding claim 3***, it is rejected applying as above rejecting claim 2, furthermore, Carse discloses the memorabilia system, wherein both surfaces of the identification tag containing identification and authentication indicia, the front face of the identification tag including text which identifies the issuing entity and text identifying the memorabilia article contained within the receptacle (Col 3, lines 64-67; Claim 10; article identity; certification indicia).

***Regarding claim 4***, it is rejected applying as above rejecting claim 3, furthermore, Carse discloses the memorabilia system, wherein a portion of the front face of the identification tag includes an area reserved for a grading mark, the grading mark providing an indication of a collectable condition designation of the memorabilia article, the identification tag further including a numerical designator indicating the quality degree within a particular condition designation ( Col 3, lines 65-67; certificate; quality).

***Regarding claim 5***, it is rejected applying as above rejecting claim 4, furthermore, Schlauch discloses the memorabilia system, wherein the identification tag further includes a serial number, the serial number comprising a unique alpha or alpha numeric sequence which specifically

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identifies the memorabilia article disposed within the housing (Col 3, lines 64-67; Claim 10; article identity; certification indicia).

7. Claims 6, and 13-16 are rejected under 35 USC 103 (a) as being unpatentable over Carse (Pat No. US 6102207) in view of DiCesare et al (Pat. No: US 5971435) further in view of Schlauch (Pat. No: US 6082774) further in view of Soules et al (Pat. No: US 5522623).

*Regarding claim 6*, it is rejected applying as above rejecting claim 5, furthermore, Schlauch discloses the memorabilia system according to claim 5, the identification tag further including: a marker area (Fig 1A, 1B, item 140, fingerprint; Col 29, Claim 43; Col 30, claim 54; fingerprint; Col 32; Claim 68, fingerprint; Fig 12A; Col 11, lines 15-27, fingerprint area). Schlauch further disclose a biological marker to be used in memorabilia article (Fig 1A, 1B, 12A, item 140, fingerprint; Claim 43,68, fingerprint; Col 8, lines 63-67; Col 11, lines 15-27; anti counterfeiting marking; biotic).

Schlauch does not expressly disclose that the biological marker invisible to the naked eye and only visible under light in specific wavelengths, the presence of the biological marker providing an indication of authenticity of the memorabilia article.

However, Soules et al discloses a biological marker invisible to the naked eye and only visible under light in specific wavelengths, the presence of the biological marker providing an indication of authenticity (Fig 1, element 16; Col 3, lines 50-55; Col 9, lines 5-15; fingerprint; indicia is visible only in specific spectrum).

References Soules et al, Schlauch, DiCesare et al, and Carse are analogous art because they are from the same field of endeavor of authenticating a portable secure document/ card.

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At the time of invention, it will be obvious to a person of ordinary skill in the art to combine the teachings of Soules et al-Schlauch with modified Carse-DiCesare system to design a memorabilia containing a biological security marking which is invisible in naked eyes, but visible in lights in different wavelength. Motivation for doing so would have been that such human invisible biological security markings are commonly used in the security articles for authentication purposes, or to provide a tamper-proof mechanism for security articles (Soules et al, Col 11, lines 5-11).

***Regarding claim 13-14***, they recite the limitations of claims 6,7, and 12, therefore, they are rejected applying as above rejecting claims 6,7, and 12.

***Regarding claim 15***, it recites limitations of claims 8, and 14. Therefore it is rejected applying as above claims 8, and 14. Furthermore, DiCesare et al discloses tracking and identifying encapsulated memorabilia article by its unique serial number (Fig 1, code number; Fig 3A, element 16, code number); verifying the serial number pertains to the corresponding memorabilia item (Fig 1, code number; Fig 3A, element 16, code number; Col 2, lines 1-5; Col 5-6, Claim 1, verifying/ matching code number); and verifying the authenticity of an article by a designation of origin and a lack of tamper evidence on their housing (Col 1, lines 51-57; Col 3, lines 27-32; tamper proof adhesive).

***Regarding claim 16***, it recites limitations of claims 6, and 15. Therefore it is rejected applying as above claims 6, and 15.

8. Claims 7-12 are rejected under 35 USC 103 (a) as being unpatentable over Carse (Pat # US 6102207) in view of DiCesare et al (Patent No: US 5971435) further in view of Schlauch (Patent No: US 6082774).

**Regarding claim 8**, it recites limitations of claim 1 and 5, therefore it is rejected applying as above rejecting claim 1 and 5. Furthermore, DiCesare et al discloses a method for authenticating a memorabilia article, the method comprising:

the autograph being inscribed on the tag in the presence of an agent of a recognized authentication service (Col 5, Claim 1, representative of authentication service);

encapsulating the memorabilia article and the identification tag in a housing within an encapsulation facility under the supervision of the authentication service (Col 5, Claim 1, representative of authentication service, witnessing autographing); and

permanently sealing the housing along a periphery, such that neither the article nor the tag may be removed therefrom without providing visible indications of tampering on the housing (Col 5-6, Claim 1, representative of authentication service, witnessing the autographing; Col 5, lines 15-21, affixed the article with tamperproof adhesive).

**Regarding claim 7**, it is rejected applying as above rejecting claim 5, furthermore, DiCesare et al discloses a memorabilia system further comprising

an authentication service (Col 3, lines 4- 35; a certificate of authenticity; Col 5-6, lines 10-20, Claim 1, authentication company/ system),

a memorabilia article registration database, maintained by the authentication service (Col 3, lines 4- 35; a certificate of authenticity, database containing certificate of authenticity, an identifying code associated with each article; Col 5-6, lines 10-20, Claim 1, authentication company/ system); and wherein the unique serial number is associated to the specific memorabilia article in the database (Col 3, lines 4- 35; a certificate of authenticity, database containing certificate of authenticity, and unique identifying code associated with each article).

*Regarding claim 9-12*, they recite the limitations of claims 3-5, 7, and 9-11, therefore, they are rejected applying as above rejecting claims 3-5, 7, and 9-11.

### ***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shanto M. Abedin whose telephone number is 571-272-3551. The examiner can normally be reached on M-F from 9:00 AM to 5:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh, can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

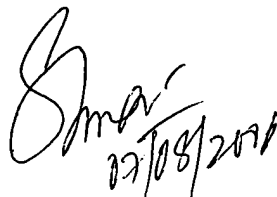
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Shanto M. Abedin

Examiner, Art Unit: 2136



Handwritten signature of Shanto M. Abedin, dated 12/18/2011.